

REMARKS

Claims 1, 3-9, and 11-22 are currently pending in this application. Claims 6 and 7 are withdrawn from consideration. Claims 2 and 10 are canceled, and claims 1, 8, 16 and 22 have been amended. No new matter is involved. Claims 1, 8, 16 and 22 have been amended to indicate, among other things, that the recited walls and screens are stationary, a fact that is apparent from Applicants' drawings and related disclosure. Applicants respectfully request reconsideration of the application in light of the amendments and remarks contained herein, and request timely allowance of the pending claims.

Rejections under 35 U.S.C. §103(a)

Claims 1 and 3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,061,061 to Robley et al. ("Robley") in view of U.S. patent 5,225,804 to Silbelus and further in view of U.S. Patent No. 3,711,812 to Cherry ("Cherry"). Claim 4 stands rejected under 35 U.S.C. 103(a) as unpatentable over Robley and further in view of Silbelus and Cherry and further in view of U.S. Patent Application No. 5,986,718 to Barwacz et al. ("Barwacz"); claim 5 stands rejected under 35 U.S.C. §103(a) as unpatentable over Robley and further in view of Silbelus and further in view of U.S. Published Pending Patent Application No. 2004/0201764 to Honda; claim 8 stands rejected under 35 U.S.C. 103(a) as unpatentable over Robley and further in view of Silbelus and further in view of U.S. Patent 6,179,426 to Rodriguez, Jr. ("Rodriguez"); claim 9 stands

rejected under 35 U.S.C. 103(a) as unpatentable over Robley and further in view of Silbelus and further in view of Rodriguez and further in view of Honda; claim 11 stands rejected under 35 U.S.C. 103(a) as unpatentable over Robley and further in view of Silbelus and further in view of Rodriguez and further in view of Cherry; claim 12 stands rejected under 35 U.S.C. 103(a) as unpatentable over Robley and further in view of Silbelus and further in view of Rodriguez and further in view of Barwacz; claim 13 stands rejected under 35 USC 103(a) as unpatentable over Robley and further in view of Silbelus and further in view of Rodriguez and further in view of U.S. Patent 6,022,124 to Bourn et al. ("Bourn"); and claims 16 and 22 stand rejected under 35 USC §103(a) as unpatentable over U.S. Patent 6,836,286 to Tachi in view of U.S. Patent 6,469,683 to Suyama.

These rejections are respectfully traversed.

Claims 1 and 3 Rejection – 35 U.S.C §103(a): Robley-Silbelus-Cherry

Applicants respectfully traverse this §103(a) rejection of claims 1 and 3. Claim 1, as amended, positively recites a number of features not disclosed by Robley. For example, claim 1 positively recites a combination of features including providing a studio with a video-taking box having four stationary walls facing one another and screens on the four walls of the video-taking box. Robley does not disclose such features and is significantly different. Robley only discloses a front projection composite photography system using a pair of perpendicular reflex screens – see the first sentence of the abstract of Robley, for example.

Thus, even if it were obvious to locate Robley's treadmill in the floor of the studio (which has not been demonstrated by the Office Action), the resulting modification of Robley would not render the claimed invention obvious.

The Office Action admits that Robley does not disclose use of a treadmill located in a floor on which the subject is located.

In an attempt to remedy this deficiency, the Office Action turns to Silbelus. However the Office Action's description of Silbelus is not complete. In point of fact, Silbelus is directed to a treadmill foot-controls for students. As explained in col. 4, lines 32+, "a student sitting in a chair with one foot on belt 10 would slide it forward along foot plate 158 with his foot whenever he would be dissatisfied with a portion of instruction." The greater a student's dissatisfaction, the farther the student would move the belt. The potential at each student terminal is displayed in real time on a monitor – see col. 4, lines 58-68.

Applicants respectfully submit that one of ordinary skill in the art would not look to Silbelus to modify Robley because Silbelus not directed to solving the same type of problem facing Robley. Silbelus is only interested in the unique situation of treadmill foot controls to be operated by students sitting at desks, whereas Robley is interested in an actor walking or running on a treadmill and is not at all concerned with merely using a treadmill for walking or running purposes.

Moreover, Robley's system is disclosed in terms of a stage and the Office Action does not explain why one of ordinary skill in the art would want to modify a stage that is used to stage many different events to be ripped up and have a

treadmill installed therein as disclosed in Silbelus that is designed to serve as foot controls for students sitting at desks.

This last argument has not even been addressed in the outstanding Office Action, as required by MPEP § 707.07(f).

Accordingly, Applicants respectfully submit that the Office Action has not made out a *prima facie* case of proper motivation to modify Robley to provide a treadmill with a stage floor and sub-floor arrangement like the classroom sub-floor and floor arrangement in Silbelus and, for this additional reason, fails to provide a *prima facie* showing of obviousness of the claimed invention.

Furthermore, claim 1 positively recites a combination of features including taking video of a subject and the background image by overlapping the subject with the background image and controlling speed of the treadmill by the subject, features not disclosed by either Robley or Silbelus.

Cherry discloses an improved drive and control system for an exercise treadmill. This treadmill differs substantially from the foot- operated treadmill switch control of Tachi and the Office Action does not explain why one of ordinary skill in the art would be motivated to modify Robley-Silbelus to include a remote control for a third party (as taught by Cherry) when Silbelus desires to get a student's response, not a third party's response.

Moreover, Robley discloses that, for scenes requiring coordinated motion between the staged scene and a background scene, "actors can be moved on conveyor belts, treadmills and/or turntables to correspond with the movement in

the background scene” (col. 5, lines 4-8). Robley’s disclosure is in terms of actors being moved on treadmills, not in terms of actors moving themselves on treadmills. The only concept of an actor moving himself or herself on a treadmill is in Applicants’ disclosure, which cannot properly be used as prior art against Applicants, as it is apparently being done here in this rejection based to a degree on hindsight reconstruction of Applicants’ invention based on Applicants’ disclosure.

Applicants respectfully submit that claims 1 and 3 are directed to a video production method reciting a combination of features that is unique and is not obvious in view of the applied art.

Accordingly, Applicants respectfully submit that the Office Action has not made out a *prima facie* case of proper motivation to modify the improper Robley-Silbelus-Cherry reference combination to provide a remote control to a third party and, even if it did, it would not result in a reference combination that would render the claimed invention obvious.

Reconsideration and withdrawal of this rejection of claims 1 and 3 is respectfully requested.

Claim 4 Rejection – 35 U.S.C §103(a): Robley-Silbelus-Barwacz

Applicants respectfully traverse the §103(a) rejection of claim 4.

Applicants respectfully submit that the Robley-Silbelus-Cherry reference combination is improper at least for reasons stated above.

Barwacz is cited to teach a chroma key device in a photobooth which includes a color adjusting circuit to adjust the color of a composite image to compensate for color shifting resulting from illuminating the subject with a light source, and adding a second light source that increases the intensity of the blue component reflected by a backdrop and allows the chroma key device to be set for a range that is less likely to be reflected by the subject.

Even if it were obvious to modify the Robley-Silbelus-Cherry reference combination to include changing one of illumination or brightness of an illumination light illuminating the subject in accordance with the background image, the resulting reference combination would not result in the claimed invention because the aforementioned Robley-Silbelus reference combination is improper and does not render obvious the subject matter of claim 1, which is included in claim 4.

Accordingly, reconsideration and withdrawal of this rejection of claim 4 is respectfully requested.

Claim 5 Rejections - 35 U.S.C §103(a): Robley-Silbelus-Cherry-Honda

Applicants respectfully traverse the §103(a) rejection of claim 5. Claim 5 depends from claim 1, and is allowable at least for the reasons, presented above, that claim 1 is allowable.

Even if it were obvious in view of Honda to include sound with the video taking, the aforementioned improper Robley-Silbelus reference combination is

improper for reasons discussed above, and would not render obvious the subject matter of claim 1, which is included in claim 5.

Accordingly, Applicants respectfully request the Examiner to withdraw this §103(a) rejection of claim 5.

Claim 8 Rejection - 35 U.S.C §103(a): Robley-Silbelus-Rodriguez

Applicants respectfully traverse the §103(a) rejection of claim 8.

Claim8, as amended, positively recites a number of features not disclosed by Robley. For example, claim 8 positively recites a combination of features including providing a studio with a video-taking box having four stationary walls facing one another and screens on the four walls of the video-taking box. Robley does not disclose such features and is significantly different. Robley only discloses a front projection composite photography system using a pair of perpendicular reflex screens – see the first sentence of the abstract of Robley, for example.

Thus, even if it were obvious to locate Robley's treadmill in the floor of the studio (which has not been demonstrated by the Office Action), the resulting modification of Robley would not render the claimed invention obvious.

The Office Action admits that Robley does not disclose use of a treadmill located in a floor on which the subject is located.

In an attempt to remedy this deficiency, the Office Action turns to Silbelus. However the Office Action's description of Silbelus is not complete. In point of fact, Silbelus is directed to a treadmill foot-controls for students. As explained in col.

4, lines 32+, “a student sitting in a chair with one foot on belt 10 would slide it forward along foot plate 158 with his foot whenever he would be dissatisfied with a portion of instruction.” The greater a student’s dissatisfaction, the farther the student would move the belt. The potential at each student terminal is displayed in real time on a monitor – see col. 4, lines 58-68.

Applicants respectfully submit that one of ordinary skill in the art would not look to Silbelus to modify Robley because Silbelus not directed to solving the same type of problem facing Robley. Silbelus is only interested in the unique situation of treadmill foot controls to be operated by students sitting at desks, whereas Robley is interested in an actor walking or running on a treadmill and is not at all concerned with merely using a treadmill for walking or running purposes.

Moreover, Robley’s system is disclosed in terms of a stage and the Office Action does not explain why one of ordinary skill in the art would want to modify a stage that is used to stage many different events to be ripped up and have a treadmill installed therein as disclosed in Silbelus that is designed to serve as foot controls for students sitting at desks.

This last argument has not even been addressed in the outstanding Office Action, as required by MPEP § 707.07(f).

Additionally, Robley discloses that, for scenes requiring coordinated motion between the staged scene and a background scene, “actors can be moved on conveyor belts, treadmills and/or turntables to correspond with the movement in the background scene” (col. 5, lines 4-8). Robley’s disclosure is in terms of actors

being moved on treadmills, not in terms of actors moving themselves on treadmills. The only concept of an actor moving himself or herself on a treadmill is in Applicants' disclosure, which cannot properly be used as prior art against Applicants, as it is apparently being done here in this rejection based to a degree on hindsight reconstruction of Applicants' invention based on Applicants' disclosure.

Accordingly, Applicants respectfully submit that the Office Action has not made out a *prima facie* case of proper motivation to modify Robley to provide a treadmill with a stage floor and sub-floor arrangement like the classroom sub-floor and floor arrangement in Silbelus and, for this additional reason, fails to provide a *prima facie* showing of obviousness of the claimed invention.

Furthermore, the Office Action admits that Robley-Silbelus does not disclose that the projector displays an image on a screen that is a wall of the video taking box. In an attempt to remedy this defect, the Office Action turns to Rodriguez, which discloses a front projection display system. The Office Action states that Rodriguez discloses that it is well known in the art that images may be projected on a wall and, in view of that teaching, concludes that it would be obvious to include the concept of projecting images on a wall in the photography studio of the Robley-Silbelus reference combination for the speculative reason that such may provide the "projection volume necessary for image expansion without any physical obstruction."

Applicants respectfully disagree.

In the first place, Rodriguez discloses that “[A]lthough images may be projected upon a large clear flat surface, such as a wall, better image quality is achieved by the use of a separate screen (col. 2, lines 39-41. In fact, Rodriguez discloses that its front projection system 100 includes a dedicated high gain projection screen 102 mounted on a frame (col. 6, lines 51-52).”

In view of these explicit teachings, it would appear that Rodriguez teaches away from using a flat wall as a screen in a video projection system and that one of ordinary skill in the art would have a disincentive to incorporate a flat wall into the aforementioned Robley-Silbelus studio.

In response to this argument, the outstanding Office Action states that, although Rodriguez discloses alternative projection surfaces, the Examiner is using Rodriguez to show that it is well known to project images onto a wall. However, the rejection is based on a specific reference which must be evaluated in light of the entire disclosure of that reference, and it is the entire disclosure of Rodriguez on which Applicants’ arguments are based. It is well settled that the Examiner may not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc., 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987) and In re Kamm, 452 F.2d 1052, 1057, 172 USPQ 298, 301-2 (CCPA 1972). Applicants respectfully submit that the Office Action improperly omits consideration of the entire disclosure of Rodriguez.

Furthermore, even if it were proper (which it is not) to modify Robley and Silbelus in view of Rodriguez, the resulting modification of Robley-Silbelus would not render the claimed invention obvious because of the features positively recited in amended claim 8.

Accordingly, the Office Action has not made out a *prima facie* case of proper motivation to modify the improper Robley-Silbelus reference combination in view of Rodriguez, as suggested and, therefore, fails to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claim 8 is respectfully requested.

Claim 9 Rejection - 35 U.S.C §103(a): Robley-Silbelus-Rodriguez-Honda

Applicants respectfully traverse the §103(a) rejection of claim 9.

Applicants respectfully submit that the Robley-Silbelus-Rodriguez reference combination on which this rejection is based is improper for reasons discussed above.

The Office Action admits that the aforementioned Robley-Silbelus-Rodriguez reference combination does not explicitly disclose a speaker, an audio storing device, an audio reproducing device, and a recording device with a microphone.

In an attempt to remedy this deficiency, the Office Action turns to Honda. Honda discloses a video camera with the missing features, and argues that it

would be obvious to use such a camera in the aforementioned reference combination.

Applicants respectfully submit that even if it were obvious to use the camera of Honda in the aforementioned improper Robley-Silbelus-Rodriguez reference combination, the resulting reference improperly combined reference combination would still not render the claimed invention obvious at least for the reasons stated above regarding the traversal of the rejection of claim 8.

Reconsideration and withdrawal of this rejection of claim 9 is respectfully requested.

Claim 11 Rejection - 35 U.S.C §103(a): Robley-Silbelus-Rodriguez-Cherry

Applicants respectfully traverse the §103(a) rejection of claim 11.

Applicants respectfully submit that the Robley-Silbelus-Rodriguez reference combination on which this rejection is based is improper for reasons discussed above regarding the rejection of claim 8.

Cherry discloses an improved drive and control system for an exercise treadmill. This treadmill differs substantially from the foot-operated treadmill switch control of Silbelus and the Office Action does not explain why one of ordinary skill in the art would be motivated to modify Robley-Silbelus-Rodriguez to include a remote control for a third party (as taught by Cherry) when Silbelus desires to get a student's response, not a third party's response.

Furthermore, the Office Action does not provide objective factual evidence of proper motivation to provide control of Robley's treadmill to an actor when Robley's disclosure of the treadmill is given in terms of actors being moved on the treadmill, not of actors moving the treadmill.

Accordingly, Applicants respectfully submit that the Office Action has not made out a *prima facie* case of proper motivation to modify the improper Robley-Silbelus-Rodriguez reference combination to provide a remote control to a third party and, therefore, fail to provide a *prima facie* showing of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claim 11 is respectfully requested.

Claim 12 Rejection – 35 U.S.C §103(a): Robley-Silbelus-Rodriguez Barwacz

Applicants respectfully traverse the §103(a) rejection of claim 12.

Initially, Applicants note that on page 12 of the Office Action, line 1, the body of this rejection refers to claim 11. Applicants will treat this as a typographical error and assume that it was meant to refer to claim 12.

Applicants respectfully submit that the Robley-Silbelus-Rodriguez reference combination on which this rejection is based is improper for reasons discussed above.

Barwacz is cited to teach a chroma key device in a photobooth which includes a color adjusting circuit to adjust the color of a composite image to

compensate for color shifting resulting from illuminating the subject with a light source, and adding a second light source that increases the intensity of the blue component reflected by a backdrop and allows the chroma key device to be set for a range that is less likely to be reflected by the subject.

Even if it were obvious to modify the improper Robley-Silbelus-Rodriguez reference combination to include changing one of illumination or brightness of an illumination light illuminating the subject in accordance with the background image, the resulting reference combination would not result in the claimed invention because the aforementioned Robley-Silbelus-Rodriguez reference combination is improper and does not render obvious the subject matter of claim 8, which is included in claim 12.

Claim 13 Rejections – 35 U.S.C §103(a): Robley-Silbelus-Rodriguez-
Bourn

Applicants respectfully traverse the §103(a) rejection of claim 13.

Applicants respectfully submit that the Robley-Silbelus-Rodriguez reference combination on which this rejection is based is improper for reasons discussed above.

Bourn discloses a machine vision system using a xenon strobe ring light source to reduce shadows in an object to be inspected, including “extremely small parts.” (col. 17, lines 8-24). Bourn essentially uses a ring light in a macro photographic setting.

There is no indication in Bourn that its ring light will provide even illumination for anything other than small parts moving on a conveyor belt, i.e., in macro photography. Applicants do not find in Bourn a disclosure that the ring light will work with a stage scene combined with one or more projected background scenes, such as the system of Robley, the main reference in the multiple reference combination applied in the rejection of claim 12.

The Office Action does not even address the significant differences in the size and arrangement of the scenes in Robley and the size and arrangement of parts on a conveyor belt and fails to demonstrate that a ring light for a convey belt with small articles to be inspected would be expected to provide optimum illumination for the relatively large stage scenes of the main reference.

In response to this argument, the outstanding Office Action notes that shadows exist in both large stage scenes and in small article inspection. Applicants agree. Applicants argument was directed to the non-obviousness of using a small ringlight designed for small parts in a significantly different sized studio with full sized actors.

Moreover, even if it were obvious to modify the aforementioned the Robley-Silbelus-Rodriguez reference combination as suggested in this rejection (which has not been demonstrated), the resulting reference combination would still not render obvious the claimed invention because the aforementioned Robley-Silbelus-Rodriguez reference combination is improper for reasons discussed above.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention recited in claim 13.

Claims 16 and 22 Rejections – 35 U.S.C §103(a): Tachi - Suyama

Claims 16 and 22 stand rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent 6,836,286 to Tachi et al. (hereinafter, “Tachi”). This rejection is respectfully traversed.

It is well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office (PTO). See, In re Piasecki, 745 F.2d 1468, 223 USPQ 785, 788 (Fed. Cir. 1984).

A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see, In re Paulsen, 30 F.3d 1475, 1478, 1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994), In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Applicants continue to respectfully submit that Tachi does not disclose any projectors, let alone the plurality of projectors recited. The Office Action admits this and turns to Suyama in an attempt to remedy this deficiency

Suyama discloses synchronizing an image displayed on a two-dimensional display device so that an observer may view the displayed two-dimensional image

as a three-dimensional image – see col. 4, lines 57-61, for example. In Suyama's first embodiment, the two dimensional display device can be (1) a CRT, (2) a liquid crystal display; (3) an LED display, (4) plasma display; (5) a projector type display; (6) a vector-scanning type display, or (7) the like.

The Office Action views this disclosure as a teaching that it is well known to supplement various types of display devices such as LED displays and projector type displays with one another and, based on this viewpoint, concludes that one of ordinary skill in the art would be motivated to replace the LED matrixes of Tachi with a projection type display as disclosed by Suyama.

Applicants respectfully disagree for a number of reasons.

Firstly, Suyama merely discloses that various different types of two dimensional display devices can be used as three-dimensional display devices.

Secondly, just because there are various different types of known two dimensional display devices that can be used to generate three dimensional images does not mean that it would be obvious to substitute a projector-type display for Tachi's LED matrix displays in Tachi's video conference system.

Thirdly, Tachi's video conference system uses revolving LED matrix displays wherein each LED matrix display can be compact, self contained, battery operated light-emitting units that are readily adapted to revolutionary movement whereas projection-type displays are typically stationary and are easily misaligned and are typically not used in a revolving environment. The Office Action fails to present objective factual evidence that one of ordinary skill in the art would be motivated

to replace a robust working LED matrix display with a projection-type display which typically is not robust and is not normally operated in a revolving manner.

Furthermore, Claims 16 and 22 are amended to recite that the walls and screens associated with each individual walls are stationary, a feature clearly not disclosed by Tachi.

Furthermore, claim 16 has been amended to positively recite a combination of features including wherein video may be taken by one or more of the cameras of both the subject and a background image viewed by a given camera, features neither disclosed nor suggested by Tachi.

Additionally, claim 22 has been amended to positively recite a combination of features including wherein video may be taken by one or more of the cameras of the subject and the background image by combining the subject and a background image viewed by a given camera, features neither disclosed nor suggested by Tachi.

The Office Action focuses on Tachi's disclosure of displaying a specific color at the moment a person is photographed and concludes that this is evidence of each camera combining the subject and background. However, this conclusion is not explicitly taught by Tachi and has not been demonstrated as being inherent (inherency requiring not just possibilities or probabilities, but that something is necessarily disclosed) in Tachi.

Moreover Applicants respectfully submit that the display of a specific color when a person is photographed may well be for the purpose of alerting the person

being photographed that they are being photographed, not for combining a subject and a background image.

Accordingly, for these additional reasons, the claimed invention recited in claims 16 and 22 is not rendered unpatentable by Tachi in view of Suyama.

Reconsideration and withdrawal of this rejection of claims 16 and 22 is respectfully requested.

Allowed Subject Matter

Applicants acknowledge with appreciation the allowance of claims 14, 15 and 17-21.

Conclusion

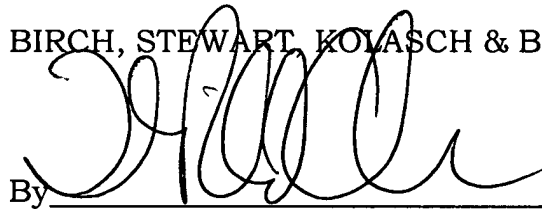
For the reasons stated above, Applicants respectfully submit claims 1, 3-9, and 11-22 are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert J. Webster (Reg. No. 46,472) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART KOLASCH & BIRCH, LLP



By

D. Richard Anderson, #40,439

P.O. Box 747

Falls Church, VA 22040-0747

(703) 205-8000

0879-0276P

DRA/RJW:mao/gf

